

REMARKS

The present invention is directed to a communication terminal having a camera shooting function such as the compact handheld foldable telephone shown in Figures 1 and 2 that can include a telephone keyboard with an array of keys, a display screen or display unit, and a camera unit capable of an image taking function and capable of displaying an image to the user on the display unit.

As can be appreciated, the communication terminal has the capability of not only sending and receiving audio signals, but also video data signals and e-mail text signals in an extremely compact communication terminal body.

The relative proliferation of compact handheld communication terminals with telephone functions of a wireless nature has created an extremely competitive environment with the specific companies that are employed in this industry seeking advantageous features to provide a competitive edge to their products. Accordingly, the novelty of any invention in this particular field should be judged in this light.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.”

Continental Can Co. USA Inc. v. Monsanto Co., 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

The present invention has the capacity to enable an image shooting mode in a communication terminal and enables a mail composition unit to extract from a recording medium storing one or more e-mail addresses associated with information indicating image transmission and to generate an e-mail message with an attachment of the shot image directed to that e-mail

address. An attaching unit, upon generation of the image data by a generating unit, can automatically attach the image data to the e-mail message generated by the mail composition unit.

These features are set forth in the currently amended and independent claims of the present invention.

The image shooting function can be single shot or a video taken over a duration of time instigated by a start instruction receiving unit and an end instruction receiving unit operated by the user. These features are found, for example, in dependent Claim 4.

Dependent Claim 5 provides a variation where the display unit will display the shot image data and a save instruction receiving unit can receive from the user an instruction to save the displayed data whereupon the attaching unit, upon an affirmative instruction to save, can automatically attach the image data to an e-mail message generated by the mail composition unit.

Dependent Claim 8 further comprises first and second operating buttons to instigate an image shooting mode to generate an image data and a second operating button that the operation of the second operating button image data is automatically attached to the selected e-mail message that has been pre-entered in the mail composition unit prior to the image shooting.

As can be readily appreciated, the above respective Claims include a shooting mode instruction receiving unit, a mail composition unit that responds when the communication terminal is switched to an image shooting mode to extract from a recording medium, storing one or more mail addresses, an e-mail address that is associated with information indicating image data transmission and to generate an e-message directed to that e-mail address.

Accordingly, when the user of our communication terminal decides to enter an image shooting mode of operation and to shoot an image, our communications terminal or control unit can automatically specify a predetermined e-mail address from an address book or table, and generate a corresponding e-mail message directed to the e-mail address so that the shot image is attached to the e-mail message. As a result, the user is spared the bother of entering or selecting e-mail addresses with image data attachments as preparatory operations with manual input.

Dependent Claim 9 further adds features of utilizing a singular operating button but holding it depressed for a period of time relative to a predetermined stored time period to generate different modes of operation.

Claim 13 was rejected under 35 U.S.C. §101 and has now been amended in accordance with the thoughtful commentary of the Examiner to render the structure of Claim 13 both structurally and functionally interrelated with the medium to perform the unique attributes of the present invention.

Claim 18 is a newly drafted claim. It does not add any new matter for consideration or examination purposes. It is drawn to a handheld communication terminal with specific telephone functioning capabilities wherein the telephone keyboard with an array of keys can be associated with a memory unit which enables the user to select or assign shutter buttons and a lookup table shown, for example in Figure 7, and executed with the process steps shown in Figure 8. Dependent Claim 19 depends from Claim 18.

These new claims are directed to a feature of uniquely assigning a shutter button function to a plurality of keys and when one of the keys is activated, it simultaneously enables a

transmission/reception unit to attach the shot image as an e-mail attachment to that specific e-mail address.

Thus, a user is given the capacity of picking from a plurality of potential shutter buttons, each associated with a separate name. This function has not been heretofore provided in a handheld communication terminal to designate a plurality of shutter buttons, each associated with a different name and e-mail address.

The Office Action contended that a picture taking kiosk, for example of the type in an amusement park or game arcade, was capable of anticipating under 35 U.S.C. §102 the subject matter of original Claims 1-5, 8-10 and 13-17 citing the *Iwamura* U.S. Patent No. 7,106,906.

“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation. . . .”

Transclean Corp. v. Bridgewood Services, Inc., 290 F.3d 1364, 62 USPQ2d 1865 (Fed. Cir. 2002)

The Office Action took a broad view of our original claims in order to utilize the *Iwamura* disclosure as an anticipatory rejection. Basically the *Iwamura* reference disclosed in Figure 1 “an amusement apparatus” as follows, Column 3, Lines 48-50:

FIG. 1 is a block diagram of a moving image amusement apparatus according to the present invention, and FIG. 2 shows its operation flow chart.

Thus, as noted with the flow chart of Figure 2, a user inserts a coin to activate the amusement device and selects a desired story in step 202. The selected story relates to background scenes, and feature players which are prestored and disclosed on a display screen. As noted in Column 7, Lines 42-57, the amusement apparatus has a box housing with an interior painted to provide a “blue back.” When the user actually enters into the amusement apparatus, a

camera can take his picture against the blue screen and thereby integrate it into the pre-stored images to produce an amusing composite moving picture.

As shown, the person can simulate being a golfer and purportedly a famous golf course can be utilized as the integrated background image to thereby enable a person to appear to play on the famous and mostly likely expensive, golf course. This function is explained, for example in Column 4, Lines 8-20 as follows:

After the story, background scene, feature player, and the like are determined, and when the user inputs a start instruction at the console 103, the motion and voice of the user corresponding to the story are captured as digital moving image information using a camera 102 and the microphone 108. The captured digital information is extracted and compressed by the processor 106 (step S204). After an elapse of a predetermined period of time, the capture process is complete, and the processor 106 composites the compressed sensed information with the selected background scene and feature player and plays back the information using the display 104 and speaker 107 (step S205). The apparatus prompts the user to check if the playback information is OK.

In a second embodiment, a variation of the first embodiment is provided in which the user must have a "portable terminal in order to receive a file generated by the compositing of images from the amusement device." The Office Action noted the teachings of Column 9, Lines 14-25 as follows:

The user must input his or her own email address in addition to the aforementioned operation. FIG. 15 shows an email address input window displayed on the display 104. When the user operates the console 103 to input his or her own email address and then operates a confirmation key (not shown), the generated moving image file is sent to the email address of that user. Note that the mail address may be input before step S202 or step S207 in FIG. 2, or the like. In step S207, the file is sent to the designated email address.

In some cases, the user may input a plurality of email addresses. In this case, the user can send the file to his or her friends.

As can be readily appreciated, the user must input an e-mail address in order to permit the previously generated moving image file to be sent to an e-mail address. The functions of the present invention in providing a lookup table of names and e-mail addresses that are stored and can be automatically accessed and utilized by the user without the necessity of a manual entering of an e-mail address is not taught by *Iwamura*.

These features are now set forth in the independent Claims 1 and 13, and are believed to more than adequately distinguish over the amusement device kiosk of the *Iwamura* disclosure.

The newly drafted Claim 18 defines a handheld communication terminal with an image shooting function and a telephone function with a telephone keyboard having an array of keys. When the *Iwamura* reference requires a portable terminal in order to receive the composite file in the second embodiment, it proposes a cell phone as a portable terminal. However, this is the full extent of its disclosure of any utilization of a cell phone. As such, the cell phone designated by the *Iwamura* reference in Column 9, Lines 32-34, is simply a portable terminal with an e-mail transmission capacity to which the processed composite image file can be downloaded.

Claim 18 specifically defines a capability of an operation control unit having a memory unit with a lookup table with e-mail addresses, names and telephone numbers and assigning or flagging specific keys in the array of telephone keys to separately perform functions as a shutter providing an image shooting by the camera unit so that the shot image can be attached to an e-mail attachment associated with the specific e-mail address associated with the assigned one of the plurality of shutter buttons.

None of the references of record, including the *Iwamura* reference, anticipates nor suggests this feature.

The Office Action further rejected Claims 6, 7 and 11 over a combination of the *Iwamura* reference when taken in view of *Arai* (U.S. Patent No. 6,642,959). As can be appreciated, Claims 6, 7 and 11 incorporate the above distinguishing features of the amended Claim 2 over that of the *Iwamura* reference.

The *Arai* reference was principally cited for its teaching of Figure 11 and its description in Column 13, Lines 8-13, that a shot image and a digital camera could be assigned an e-mail address. It does not, however, teach or suggest the features described above as distinguishing over the *Iwamura* reference and as such, its combination under 35 U.S.C. §103 would still not teach or suggest the current features defined in the present claims.

It is the Examiner's burden to establish *prima facie* obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Here, we find that the Examiner has not identified all the elements of claim 1, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

Ex parte Karoleen B. Alexander, No. 2007-2698, slip op. at 6 (B.P.A.I. Nov. 30, 2007)

The Office Action further rejected Claim 12 over a combination of the *Iwamura* reference in view of *Obradovich* (U.S. Patent No. 6,525,768). Basically, the *Obradovich* reference taught a positional camera and a GPS data interchange device wherein the location of a picture can be associated with coordinates received by a GPS system.

Obradovich does not address the features of our current claims that distinguish over the *Iwamura* reference and was apparently selected simply for a GPS feature in isolation from the

true teachings of the *Iwamura* reference. Certainly the *Iwamura* reference, dedicated to an amusement kiosk, does not teach nor suggest a GPS receiver. This is clear to the user and to the owner of the amusement kiosk where the exact location of this commercial device is located. The GPS system of *Obradovich* in such an environment would be superfluous and would only be cited in hindsight from the template of our present application as an unrelated aggregate feature not necessary in the principal *Iwamura* disclosure.

Certainly there is no articulated explicit analysis as to how or why a person of ordinary skill in the field from *Iwamura* amusement device would want to insert a GPS system. The GPS system utilized, for example in a communication terminal that is movable since it is handheld and compact, would have more validity than that of the *Iwamura* teaching.

In summary, the basic *Iwamura* reference is not configured nor does it suggest an ability to automatically activate a mail function when the communication device is switched into an image shooting mode. More specifically, *Iwamura* is not configured to generate an e-mail message to a predetermined e-mail address upon entering into the image shooting mode. The user of the amusement kiosk of the *Iwamura* disclosure must manually input an e-mail address, shoot an image, and transmit the shot image as an e-mail attachment.

Thus, the apparatus of *Iwamura*, besides being an amusement kiosk, is not enabled to automatically retrieve a predetermined e-mail message from, for example an address book or lookup table, nor is it a compact handheld device, capable of generating an e-mail message directed to a retrieved stored e-mail address.

Our present invention as defined by our current claims, is enabled to generate an e-mail message even while the communication terminal is not in the e-mail edit mode because the

communication terminal automatically activates a mail function upon entering into the image shooting mode. As such, our communication terminal can automatically generate an e-mail message to each e-mail address stored with information indicating image data transmission. The information can correspond to the auto-attachment flag described in our specification and shown, for example in Figure 4 and a shot image is automatically attached to the e-mail message.

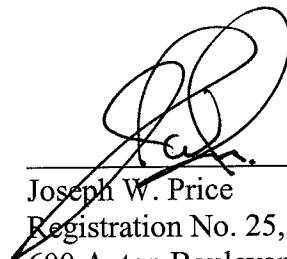
As can be appreciated, the *Iwamura* reference which is the basic reference relied upon to reject our original claims, requires the user to go through the steps of generating an e-mail message by first providing a call mail composition menu, inputting an e-mail address, select an image shooting from the menu items, and press an image shooting button. As such, our present invention provides a novelty that is neither suggested nor taught by *Iwamura* and is certainly not suggested or taught by the secondary references.

In view of the above comments and amendments to the claims, it is believed the case is now in condition for allowance and early notification of the same is requested.

If the Examiner believes that a telephone interview will help further the prosecution of this matter, he can contact the undersigned attorney at the listed phone number.

Very truly yours,

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